06/22/01

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Paper No. 16
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Family Pharmacare Center, Inc.

Serial No. 75/327,773

James E. Bradley of Bracewell & Patterson, L.L.P.
for Family Pharmacare Center, Inc.

Virginia T. Isaacson, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Cissel, Hohein and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Family Pharmacare Center Inc. has filed an application to register the mark FAMILY PHARMACARE for "retail pharmacy services, featuring prescription drugs, medicines, and pharmaceuticals."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark PHARMACARE, which is registered for

[1] Serial No. 75/327,773, filed July 18, 1997, claiming a first use and first use in commerce date of March 8, 1993.

"computerized medical history and prescription services" in Class 42 and "administration of employee pharmaceutical benefits" in Class 36.[2] The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*[3] factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999).

Looking first to the marks, the Examining Attorney maintains that the marks PHARMACARE and FAMILY PHARMACARE create similar overall commercial impressions. She argues that the term FAMILY in applicant's mark simply describes the group for whom the pharmaceutical services are being

[2] Registration No. 1,986,549, issued July 16, 1996, setting forth a first use and first use in commerce date of May 13, 1988.
[3] In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

provided, making PHARMACARE the dominant portion of the mark.

Applicant contends that the presence of the term FAMILY in applicant's mark significantly changes the sound, appearance and meaning of applicant's mark from registrant's mark and consequently the commercial impressions created by the two marks. Applicant argues that FAMILY PHARMACARE, when used in connection with an actual pharmacy location conveys the image of a local shop, whereas PHARMACARE, when used in connection with a service provider marketing to health plans and employers conveys the image of a major benefits management corporation.

While it is true that marks must be considered in their entireties in determining likelihood of confusion, when a newcomer has appropriated the entire mark of a registrant and has added thereto a non-distinctive term, the marks are generally considered to be confusingly similar. In other words, if the dominant portion of the marks is the same, then confusion is likely not-withstanding peripheral differences. See In re Denisi, 225 USPQ 624 (TTAB 1985) and the cases cited therein.

Here, while there are obvious differences in the marks in their entireties in terms of sound and appearance, the presence of the additional term FAMILY in applicant's

mark is of minimal significance in the overall commercial impression created by the mark. The term PHARAMACARE clearly is the dominant portion of applicant's mark, with the term FAMILY being highly suggestive of those for whom the services are being provided. As such, applicant has done no more than appropriate registrant's mark and add a non-distinctive term thereto, which is not sufficient to avoid a likelihood of confusion.

There are two exceptions which are made to the general rule set forth in *Denisi*: (1) where the common portion is not likely to be perceived as the source-distinguishing portion due to its descriptiveness or the commonness of its use, and (2) where the marks in their entireties convey significantly different commercial impressions. *Supra* at 625.

Although applicant argues that the first exception applies here in that the term PHARMACARE is weak or descriptive, being "merely a shorthand for pharmaceutical care," we do not agree. Applicant has presented no evidence of use of the telescoped term by others in connection with pharmaceutical services. Thus, for purposes of our analysis of the marks, we must assume that the term PHARMACARE is a coined term, although suggestive in nature of some aspect of pharmaceutical care, with no

common use in the field. As such, PHARMACARE clearly serves as a indicator of source.

Nor does the second exception apply. As previously stated, the commercial impression created by the term PHARMACARE is not significantly changed by the addition of the term FAMILY. We find no reason whatsoever to adopt applicant's interpretations of the varying connotations of the two marks. PHARMACARE remains a telescoped term, conveying the suggestion that the services with which it is used involve some aspect of pharmaceutical care. The presence of the additional term FAMILY in applicant's mark does not alter this connotation. The overall commercial impressions of the two marks are very similar.

Turning to the services involved in this case, we note the general principle that the issue of likelihood of confusion must be determined on the basis of the goods and/or services as identified in the application and in the cited registration(s). Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed.Cir. 1987). It is not necessary that the goods and/or services of the applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods and/or services are related in some manner and/or that the

conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate, or are associated with, the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

From the identifications of services in the application and registration, we find that a sufficient relationship exists between the services of applicant and registrant. Applicant offers "retail pharmacy services," which obviously involves the filling of prescriptions. Registrant's services include "computerized prescription services," which would also involve the filling of prescriptions. Although a distinction may be drawn between having one's prescriptions filled at a retail store versus obtaining the same via an on-line or other form of computerized service, the service performed is essentially the same and the end result is the same.

Applicant argues that registrant's services are directed to the management of employee pharmaceutical benefits as a part of an employer's health plan for its employees and that only as a part of these services does registrant offer "computerized medical history and

prescription services." Applicant has submitted specimens from the registration file which applicant claims show that registrant does not operate pharmacies or fill prescriptions. Applicant contends that registrant simply maintains a network of pharmacists and pharmacies that are "in the plan" for use by members of the plan.

Looking at those specimens, however, we note that registrant describes its services in connection with the delivery of pharmacy benefits as including not only an "accredited retail pharmacy network" but also "the option of prescriptions-by-mail service." Thus, even though the pharmacies to which registrant's plan members may go for the filling of their prescriptions operate independently from registrant and are merely accredited by registrant, at the same time members have the option of having their prescriptions filled directly by registrant through its mail order service. In addition, the Examining Attorney has made of record registrant's Webpage which shows that registrant offers to plan members the option of "order your prescriptions online" as well as "find a pharmacy near you." Such as online service clearly exemplifies registrant's provision of "computerized prescription services" as part of its own services, and that its

services are not limited to referral to participating pharmacies.

It is true that distinctions may be made between the channels of trade for the two services, in that applicant's services involve a retail store, whereas registrant's computerized services may be offered over the Internet or as part of its mail order service.

We cannot agree with applicant's argument, however, that a distinction can also be made between the consumers, on the premise that registrant's services are marketed only to an employer who wishes to offer pharmaceutical benefits to its employees and that pharmacy referral services are simply part of registrant's function as a benefits management company. While registrant may market its pharmaceutical benefit plan to employers, the ultimate consumers of the benefits are the plan members, the employees. These employees will encounter registrant's mark PHARMACARE while taking advantage of the pharmaceutical benefits offered by the plan, one of which is the option of ordering prescriptions directly from registrant through a computerized prescription service. These very same persons may well encounter applicant's mark FAMILY PHARMACARE should they elect the other option, namely, filling their prescriptions in a retail pharmacy.

We have no doubt but that, because of the similarity of the respective marks, confusion as to source is likely.

The only other factor raised by applicant is that of the lack of actual confusion, despite concurrent use for nearly eight years. We can give little weight to this fact, however, under the present circumstances. In the first place, registrant has not had the opportunity to be heard from on this point. See In re National Novice Hockey League, Inc., 222 USPQ 638 (TTAB 1984). Second, we have no information as to the extent of promotion or use by applicant of its mark or whether it operates more than one pharmacy, in other words, whether there has been any real opportunity for confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768 (TTAB 1992).

Accordingly, on the basis of the similarity of the overall commercial impressions of the marks PHARMACARE and FAMILY PHARMACARE and the relationship found to exist between registrant's computerized prescription services and applicant's retail pharmacy services, we find that confusion is likely to result from contemporaneous use of the marks.

Decision: The refusal to register under Section 2(d) is affirmed.